

### REMARKS

This amendment is submitted in response to the Examiner's Action dated February 14, 2005. Applicants have amended the claims to reconcile an element of the claims with the description provided by the specification. No new matter has been added, and the amendment places the claims in better condition for allowance. Applicants respectfully request entry of the amendments to the claims. The discussion/arguments provided below reference the claims in their amended form.

### CLAIMS REJECTIONS UNDER 35 U.S.C. § 112

At paragraph 5 of the Office Action, Claims 1, 6 and 11 are rejected under 35 U.S.C. § 112, first paragraph. Specifically, those claims are rejected for reciting the element "comparing an amount of data processing...", which Examiner states is not described in the specification.

Examiner points to (and relies on) Applicants' description on page 10, line 26 – page 11, line 8 of the specification, which generally describes several of the major features of Applicants' invention. Notably, Examiner acknowledges Applicants' description of the use of a complexity determination to determine how to store the units (i.e., device-dependent or device-independent). As provided by the specification, this process occurs within the "a priori" mode, in which "device-dependent formats are computed in advance for selected known output devices" (page 10, lines 18-19). Further, lines 28-31 describe units classified as "non complex" as "data types that do not require intensive processing for generation of the device-specific format." *See also*, page 3, lines 28 - page 4, line 1, which describes the use of the amount "processing power for presentation" as the criterion by which the units are determined to be stored in either device-dependent or device independent formats.

In addition to this description, however, Applicants' specification further provides some clarification of what is being utilized to determine complexity of the unit. For example, page 13, lines 1-4 of the specification states: "[o]nce the document ... into units, ... **how much processing power is required to convert... to device independent format**" (*emphasis added*). This sentence, when combined with the remaining description on pages 10-11 clearly provides for a

determination being made on when to store the units in device independent/dependent format based on a complexity, determined by the amount of processing power required to convert the data.

From the above, it is clear that Applicants filed specification supports the recitation of the determining process recited by Applicants amended claims and the use of the amount of required processing to determine how to store the unit(s). The amendment of the claims to more clearly recite this feature thus overcomes the §112 rejection, and Applicants respectfully request reconsideration of the rejection in light of the amendment and present arguments.

**CLAIM REJECTIONS UNDER 35 U.S.C. § 103**

At paragraph 7 of the present Office Action, Claims 1-2, 4-7, 9-12 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Alam, et al.* (U.S. Patent No. 6,336,124) in view of *Hohensee, et al.* (U.S. Patent No. 5,813,020), *Vanderwiele, et al.* (U.S. Patent No. 5,767,833) and *Orton, et al.* (U.S. Patent No. 6,590,674).

The above rejection has been addressed in detail in the arguments provided within the Appeal Brief and previous responses. Applicants therefore incorporate by reference the arguments previously proffered by the Appeal Brief with respect to the specific elements of the claimed invention. Additionally, however, Applicants now provide the following updated arguments covering the amended element and others:

**A. The Step of "Determining" is Not Shown or Suggested**

With respect to each independent claim (e.g., claim 1), therein is recited the step of:

*for each unit, determining whether the unit is complex based on an amount of data processing required to convert said unit to device-dependent format*

None of the references (neither *Orton, Vanderwiele, Alam*, nor *Hohensee*) individually, nor in combination with each other, show or suggest the "determining" element recited by each independent claims. Examiner has not specifically provided any arguments supporting the rejection of this element of Applicants' claims. That is, no specific arguments are provided addressing the original "comparing" step provided within the claims.

*Vanderwiele's* description at col. 5, line 19 – col. 6, line 12 does not provide any suggestion of a determination of a complexity of the unit based on the amount of data processing required to convert the unit to device-dependent format. As explained in cols. 5 and 6 and as seen at steps 304, 306, 310, 320, 308 and 330 (of Fig. 3), the only comparison or determination made in the flow of the methodology described in Fig. 3 is of the device and image type. Most importantly, the conversion from device independent bits to device dependent bits is performed in every case presented to the methodology (see end blocks 314, 328 and 338) and not in selected cases in response to any complexity determination. The only determination made by the system is what resolution or device-dependent format the image should be converted to. *Vanderwiele* therefore does not show or suggest this feature of the present invention.

**B. The Prior Art Fails to Show or Suggest the “Storing” processes recited by the claims**

The independent claims further recite:

*storing said units, requiring less than a predetermined level of data processing to convert to device-dependent format, in device-independent format*

*storing said units, requiring more than said predetermined level of data processing to convert to device-dependent format, in device-dependent format based on the classified plurality of presentation devices;*

Again, all arguments proffered in the Appeal Brief addressing these elements are hereby incorporated by general reference thereto. Applicants reiterate that none of the cited art suggests either of the above steps since none of the prior art even contemplates conditioning such a conversion or the storage thereof on a complexity determination based on the amount of data processing required to convert the unit to device-dependent format.

**C. Improper Hindsight Has Been Used to Reject the Claims**

Applicants incorporate the argument related to improper hindsight reasoning presented in the Appeal Brief and reiterate that to support several of the rejections, the Examiner presents as “evidence” a bare assertion that the logical process of determining whether to store units in dependent or independent formats is obvious without citing a single reference that performs or suggests making such a complexity determination before storing the units. Applicants again submit that the Examiner has not set forth evidence sufficient to support a prima facie case of

obviousness. The Examiner's evidence of obviousness is created from broad conclusory statements about the knowledge of those with ordinary skill in the art without any objective evidence of a suggestion for making the complexity determination and then storing the units accordingly, as performed in Applicants' independent claims. However it is established that "[d]etermination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention." *ADT Corp. v. Lydall, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002).

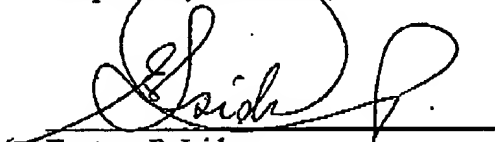
Given the above reasons, it is clear that the combination of references does not suggest key features of Applicants' invention, and one skilled in the art would not find Applicants' invention unpatentable over the combination(s). The above claims are therefore allowable over the combination(s).

**CONCLUSION**

Applicants have diligently responded to the Office Action by amending the claims to more accurately recite the features of the invention. Applicants have further provided conclusive arguments in support of the amendments, which arguments support entry of the amendments, while overcoming the specific 112, first paragraph, rejection. Applicants further provide arguments that conclusively rebut the 103(a) rejections of the claims. Since the amendments and arguments overcome the §112 and §103 rejections, Applicants respectfully requests reconsideration of the rejections and issuance of a Notice of Allowance for all claims now pending.

Applicants further respectfully request the Examiner contact the undersigned attorney of record at 512.343.6116 if such would further or expedite the prosecution of the present Application.

Respectfully submitted,



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